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10/826,042	04/15/2004	Toru Kaneda	04231/LH	9450

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EXAMINER

NGUYEN, THONG Q

ART UNIT PAPER NUMBER

2872

DATE MAILED: 02/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/826,042

Applicant(s)

KANEDA, TORU

Examiner

Thong Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/12/04</u> .  | 6) <input type="checkbox"/> Other: ____                                     |

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Drawings***

2. The drawings contained five sheets of figures 1-8B were received on 4/15/2004. These drawings are approved by the Examiner.

### ***Specification***

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
4. The disclosure is objected to because of the following informalities: Page 3: lines 6-9, the brief descriptions of figures 4 and 5 are unclear. What is/are the difference(s) between the two figures as stated by the descriptions thereof "Fig. 4 is...microscope apparatus"? Appropriate correction is required.
5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification has not provided a proper antecedent basis for the feature thereof "the notch is (a ?) V-shaped" as recited in claim 9, lines 1-2. Applicant should note that while the drawings shown a V-shaped notch (see figures 1-2, 4-5, for example); however, the specification has used the terms thereof "wedge-

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shaped” for the notch 11a (see page 5, line 8). The specification has not disclosed that the notch 11a of the wedge diaphragm 11 is a V-shaped notch as recited in the claim.

### ***Claim Objections***

6. Claim 14 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

The claim 14 recites that the notch is tilted with respect to the light source and continuously change the angle between sides of the notch (see claim 14, lines 1-3); however, such a tilt of the notch and to change the angle between sides of the notch as claimed is not considered as a movement of the unit in a direction perpendicular to the optical axis of the light source. Applicant should note that the base claim 1 recites that the adjusting unit (which as understood contains the notch) is moved in a direction perpendicular to the optical axis of the light source for changing the amount of light.

7. Claim 5 is objected to because of the following informalities. Appropriate correction is required.

In claim 5: on line 2, the phrase thereof “the sample includes a fluorescent objects” contains a grammatical error. Should “objects” (line 2) be changed to --object--?

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-7, 9-11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Osa et al (EP 1 008 884, submitted by applicant).

Osa et al disclose a microscope having an illuminating system. The illuminating system as described in page 6 and shown in figure 7 comprises an area-light source system (20-26) which emits uniform area light on the sample (30) and an adjusting unit (40) disposed on the illuminating light path for adjusting the size and shape of the light illuminating the sample and viewed by an objective lens system of the microscope. The microscope as provided by Osa et al can be a stereomicroscope which as understood comprises two eyepieces whose field of views are aligned on the plane wherein the images of the sample are formed which plane is perpendicular to the optical axis of the illuminating light. See pages 7-8. Regarding to the adjusting unit for adjusting the size and shape of illuminating light, in page 9, section [0063], for example and figs. 27(A-C), Osa et al disclose a unit having two shades (40c, 40d) and a mechanism for controlling the movements to the two shades. The shades in combination defines a V-shaped notch/opening whose width is expanded in a continuously and monotonously manner. See fig. 27A. The movement of at least one shade

member (40c or 40d) will change the size and shade of the notch/opening and thus will change the size and shape of the illuminating light incident on the sample (30). In other words, the angle defined by the notch is able to change from 0 degree to 180 degrees when the shade (40d) rotates about a pivoting/rotting point. See figures 27A-27C. The sample can be a sample contained fluorescent agent is stated by Osa et al as can be seen in page 16, section [0153]. Since the sample in the form of cells contained fluorescent agent attached thereto, thus a change in size and shape of the shapes (40c, 40d) will provide a user means for illuminating fluorescent elements and non-fluorescent elements of the cells in order to view different elements of the cells including the state in which there are only the non-fluorescent elements of the cells are illuminated and viewed.

Regarding to the distance between the sample and the adjusting unit as recited in present claim 11, such a feature is disclosed by Osa et al as can be seen in pages 11-12 and figs. 7 and 31. In other words, the distance from the lens surface (r1) of the condenser lens to the sample is about 33.8 mm and the adjusting unit is disposed at position P1 which is farther from the sample than the position of the lens surface (r1) of the condenser.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 14-16, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Osa et al (EP 1 008 884).

Osa et al disclose a microscope having an illuminating system. While Osa et al teach that the movements of the shades (40c, 40d) disposed in the illuminating light path are for adjusting the size and shade of the illuminating lights; however, they do not explicitly state that the movements of the shades are made by the tilt of the notch of the adjusting unit or the pivot of the adjusting unit around a line joint as recited in present claims 14 and 16 or the notch is formed on a light shading object as recited in present claim 15. However, the change/adjustment of size and shade by tilting or pivoting about a line joint as well as the formation of the notch on a shade object as claimed are merely that of a preferred embodiment and no criticality have been disclosed. The support for that conclusion is found in the present claims in which applicant has claimed different structure of the adjusting unit as well as the manner in which the size and shade is adjusted. For instance, the movement of the adjusting unit can be made by pivoting the two shades about a pivot point is claimed in present claim 13. Thus, absent any showing of criticality, it would have been obvious to one skilled in the art at the time the invention was made to modify the adjusting unit provided by Osa et al by forming an opening on a single shade and pivoting/tilting the shade about a pivot point or a line point for the purpose of varying/adjusting the size and shade of the light illuminating a sample.

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12. Claims 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osa et al (EP 1 008 884) in view of Steinberg (U.S. Patent No. 4,673,260) .

The microscope having an illuminating system as provided by Osa et al does not explicitly state that the ratio of areas of field of view of the eyepieces is between 1.03:1 and 1.3:1 as claimed in present claim 8 and the angle of inclination between the sample the optical axis toward the eyepiece corresponding to the field of view from the sample is between 10 to 15 degrees as claimed in present claim 12; however, the use of a stereomicroscope having eyepieces inclined in the ranges claimed is known to one skilled in the art as can be seen in the stereomicroscope provided by Steinberg. In columns 3-4 and fig. 1, for instance, Steinberg discloses a stereomicroscope having two eyepieces whose field of views are aligned onto the sample wherein a mechanism is used to adjust the inclination angle defined by the two field of views of the eyepieces. Since the two fields of views of the eyepieces are aligned onto a common point thus the ratio of areas of field of view of the eyepieces is about 1 which is inside the range of 1.03:1 and 1.3:1 as claimed. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the stereomicroscope having an illuminating system as provided by Osa et al by utilizing a mechanism as suggested by Steinberg for the purpose of alignment the field of views of two eyepieces onto a sample. It is also noted that it would have been obvious to one skilled in the art to utilize the adjustment system provided by Steinberg for the purpose of adjusting the inclination angle of the eyepieces with respect to the



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sample in a suitable range including the range of 10 to 15 degrees for the purpose of providing an optimal view of the sample.

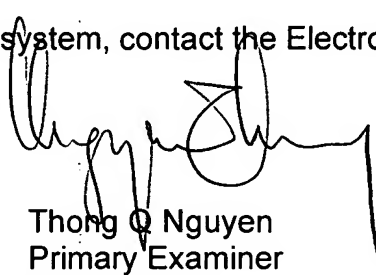
***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q. Nguyen  
Primary Examiner  
Art Unit 2872

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